

## REMARKS

### *Claims*

It is kindly requested to cancel all claims **24-38** presented in the preliminary amendment filed on 8/13/2004 and enter newly presented claims **39-61**. The newly presented claims **39-61** in this preliminary amendment are similar to the originally filed claims with the exception of amendments required to overcome the claim objections and rejections under 35 USC paragraph 112.

### *List of Inventors*

In the preliminary amendment filed on 8/13/2004, it was requested to delete David Bloom as an inventor based on claim amendments (37 CFR 1.48(b)). However, since the newly presented claims are similar to the originally filed claims inventor David Bloom should be re-instated as an inventor.

It is noted that 37 CFR 1.48 does not include a provision for reinstating an inventor after the submission of an amendment pursuant to CFR 1.48(b). However, in view of the new claims submitted herewith, applicant requests the office to correct the record by reinstating David Bloom as an inventor in this application. An executed declaration for the instant patent application was filed on 7/7/2004 listing David Bloom as one of the inventors of certain of the originally filed claims. Thus applicant believes no additional documents need to be filed with the Office.

***Claim Objections***

Claims **24** and **38** are objected to because of minor spacing problems.

In reply, the Applicant herewith submits claims **39** and **60**, which are similar to claims **24** and **38** respectively. The Applicant further submits that the minor spacing problem with respect to “a reservoir connected to an aperture” as objected to is corrected in new claims **39** and **60**.

The second objection related to former claim **39**, now claim **60**, has been corrected by specifying in claim **60** that “.... said flow regulator comprises at least one of a flexible housing, a flexible membrane pump or a light sensitive polymer flow regulator”.

***Claim rejection – 35 USC 112***

Claims 27-31, 34 and 38 are rejected under 35 USC 112, second paragraph.

**Claims 27, 28 and 30:**

In reply, the Applicant presents new claim 44 stating “a housing having at least one aperture and a surface biocompatible with at least a portion of a neuronal cell, said surface being micropatterned for directing growth of a neuronal process to said aperture”.

Claims 28 (now claim 45) and 30 (now claim 46) depend from claim 27 (now claim 44).

The amendment to claim 44 makes the rejections to claims 28 and 30 moot.

**Claim 29:**

In reply, the Applicant would like to point out that former claim 29 is not included in the new claim set.

**Claim 31:**

In reply, the Applicant presents new claim 47 stating “wherein said surface comprises a well, said aperture connecting said well with said reservoir”.

**Claim 34:**

In reply, the Applicant presents new claim 50 stating “... wherein said housing is comprised of two layers ....”.

**Claim 38:**

In reply, the Applicant presents new claim **61** stating “said flow regulator comprises at least one of a flexible housing, a flexible membrane pump or a light sensitive polymer flow regulator”.

***Claim rejections – 35 USC paragraph 102***

Claims **24** and **26** are rejected under 35 USC 102(a) as being anticipated by Fishman et al., May 2002.

In reply, the Applicant would like to point out that the Fishman paper is not by “others”. Fishman is an inventor on this application as well as on the priority documents to which this invention claims priority. Furthermore, the Applicant would like to point out that the present application claims priority from US Provisional Application 60/301,934 filed on 6/29/2001, which antedates Fishman et al. Thus, Fishman et al. is not prior art to this patent application.

***Double Patenting***

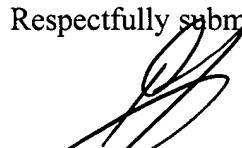
Claims **24**, **26-32** and **34-35** are provisionally rejected under the judicially doctrine of obviousness-type double patenting as being un-patentable over claims **1**, **3**, **6**, **36**, **40** and **43** of co-pending US Patent Application No. 10/184,210.

In reply, the Applicant hereby files a terminal disclaimer to obviate the provisional double patenting rejection over co-pending US Patent Application No. 10/184,210.

## CONCLUSION

The Applicant hereby submits new claims **39-61**. Applicant believes the new claims in this reply place the application in a condition for allowance. Accordingly, allowance of the claims now in the application is kindly requested.

Respectfully submitted,



Ron Jacobs, Reg. No. 50,142  
LUMEN Intellectual Property Services  
2345 Yale Street, 2<sup>nd</sup> Floor  
Palo Alto, CA 94306-1429  
Phone: (650) 424-0100